

Appl. No. : 09/493,794
Filed : January 28, 2000

REMARKS

In response to the Office Action mailed February 28, 2006, Applicants have canceled Claims 11-25 and 31-34. Applicants have also amended Claims 1, 4-7, 9 and 10 to clarify the subject matter sought.

Withdrawn claims

Applicants have canceled Claims 11-25 and 31-34 as drawn to unelected inventions. Applicants reserve the right to pursue these or similar claims in subsequent divisional or continuation applications.

Rejections Under 35 U.S.C. §112

The Examiner has rejected Claims 1-10 under 35 U.S.C. §112, second paragraph for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In particular, the Examiner asserts that the preamble of Claim 1 is directed to a product, yet the limitations are directed to both a product and a method.

In response, Applicants have amended the claims to clarify that structures are claimed. Note that a structure can be limited by recitation of its function. *In re Bernhart*, 163 U.S.P.Q. 611, 615-16 (CCPA 1969) (“If a machine is programmed in a certain new and unobvious way, it is *physically* different from the machine without that program...”). As noted in the application, “the embodiments as described above may be implemented in many different embodiments of software, firmware, and hardware in the entities illustrate in the figures.... a person of ordinary skill in the art would be able to design software and control hardware to implement the embodiments based on the description herein.” Application as filed at p. 21, lines 11-19.

Rejections Under 35 U.S.C. §102

Applicants note with appreciation the Examiner’s acknowledgement that the press release dated August 1999 (“the ChemConnect press release) constitutes only *prima facie* prior art under 35 U.S.C. §102(a), and reserve the right to swear behind the publication date under 37 CFR §1.131.

However, Applicants submit that the reference fails to teach each and every feature of the claims, and so fails to provide a *prima facie* case of anticipation . As noted in the prior response, dated November 19, 2001, the ChemConnect press release discloses only use of “an open, neutral market for chemical manufacturers, buyers and intermediaries to conduct real-time, online

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transactions for all types of chemicals." The ChemConnect press release fails to disclose each and every feature of the system in Claim 1, including the recited network, clearinghouse computer server, web browser, enterprise resource planning system and translation server.

Note that Claim 1 as amended recites, among other things, a translation server "configured to convert data in a format of the enterprise resource planning system into a converted format of the clearinghouse computer server." As explained in the application as filed, this translation server addresses use of incompatible data formats by members of the clearinghouse mechanism.

In view of the amendments, clarifying the structural elements of the claimed system, and in view of the failure of the press release to teach or suggest each and every feature of pending Claim 1, Applicants respectfully submit that the rejections are overcome.

CONCLUSION

In view of the foregoing amendments and remarks, Applicants submit that the pending claims are allowable over the art of record and respectfully request allowance. If, however some issue remains, Applicants request that the Examiner call the undersigned for authorization.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

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By: Adeel Syed Akhtar
Adeel S. Akhtar
Registration No. 41,394
Attorney of Record
Customer No. 20,995
(415) 954-4114

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